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TRANSMITTAL FORM

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Application Number	09/784,394
Filing Date	February 15, 2001
First Named Inventor	Marc Eller
Art Unit	2611
Examiner Name	Jason Salce
Attorney Docket Number	12179-P081P1

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
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- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
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- ☑ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
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Remarks

Supplemental Appeal Brief

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Date	11-9-04	Reg. No.	36,571

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application: Eller et al.

Serial No.: 09/784,394

Filed: February 15, 2001

Art Unit: 2611

Examiner: Jason Salce

For: SYSTEM AND METHOD FOR SELLING ADVERTISING SPACE ON ELECTRONIC DISPLAYS USING DIGITAL TELEVISION SPECTRUM

Mail Stop Appeal Brief - Patents
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SUPPLEMENTAL APPEAL BRIEF

I. REAL PARTY-IN-INTEREST

The real party in interest is SI Diamond Technology, Inc., who is the assignee of the entire right and interest in the present Application.

CERTIFICATION UNDER 37 C.F.R. § 1.8

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Toni Stanley
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II. RELATED APPEALS AND INTERFERENCES

The parent application to this application, Serial No. 09/553,012, is also under an appeal to the Board.

III. STATUS OF CLAIMS

Claims 5-6 and 14-20 are pending in the Application, and also stand rejected.

IV. STATUS OF AMENDMENTS

Amendments to the claims were filed after the final rejection, but not entered by the Examiner.

V. SUMMARY OF THE INVENTION

Outdoor billboards are located throughout the United States and even worldwide. Traditionally, billboards have been of the paper/poster type, where the ad on the billboard must be manually changed on a periodic basis using one or more workers. As a result, for a definitive period of time, usually one month or longer, only a single ad can be displayed on any particular billboard.

FIGURE 2A illustrates an outdoor billboard 201 having an electronic display 200. A processor and memory device, along with driver electronics and software are located at the electronic billboard site. The images to be displayed can be stored within the memory, and then are displayed in a desired manner using software. For example, a multitude of different ads can be displayed at different and preselected frequencies and durations of time. The ads can be uploaded to the billboard system remotely using a digital television broadcast network See 403 in FIGURE 4 and FIGURE 7. As a result, a central location can upload various ads to various

billboards located across the United States (FIGURE 1 illustrates an example of electronic billboards, noted by X's, throughout the United States), or even worldwide.

Referring to FIGURE 3, a client who wishes to display their ad on a particular billboard somewhere within the world will log onto a network, such as the Internet, and visit the web site operated by the billboard provider. In step 302, the client may view a map with indications where the billboard provider's electronic billboards are located.

In step 303, the client will select a billboard. In step 304, a list of open times and their durations available for ad space at the selected billboard is provided to the client. The client, in step 305, can then select an available time slot and duration. Upon selection of the available time slot and duration, the cost for the ad space may be provided to the client in those instances where a fee is applicable. In step 306, the client will purchase the desired amount of time (if applicable). In step 307, the client proceeds to prepare their own ad (or other information to be displayed) for display. Once the ad is created, then the client may upload the created ad to a central location for approval by the billboard provider in step 308. Certain pre-approved clients may be able to skip step 308 and upload their ad directly to the billboard system. In step 309, once approved, the ad is scheduled by the billboard provider for downloading to the selected billboard system for display at the desired time and duration.

VI. GROUNDS OF REJECTIONS

1. The Examiner has asserted that the provisional patent applications relied upon for priority do not support the claim limitation "digital television broadcast network."

2. Claims 5, 6, 14 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Carney et al.* (U.S. Patent No. 6,408,278) in view of *Rhoads* (U.S. Patent No. 6,411,725).

3. Claims 15-18 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Carney* in view of *Rhoads* and further in view of *Hunter* (U.S. Patent No. 6,430,605)?

VII. ARGUMENTS

1. The provisional patent applications relied upon for priority support the claim limitation "digital television broadcast network."

In Paper No. 20, the Examiner agreed that the first, second and third information handling systems recited in the claims are supported within the provisional patent applications. However, the Examiner still asserted that "digital television broadcast network" was not supported by the provisional applications. The Examiner asserted that these applications disclosed a cable network and also that the Internet is also disclosed, but nowhere is there a disclosure of a digital television broadcast network. Applicants respectfully disagree.

Page 5, line 14 of the '602 application (60/130,602) discloses that the ads can be uploaded to the billboard system using various telecommunication systems, including cable. Page 6, lines 4-6 describe how the third information handling system (client computer) will access the billboard provider website over a network. It is well known in the art that access to the Internet may be provided using a cable network. In the '673 application (60/147,673), it is described how data transmission to and from the billboards can be performed using cable technologies. Page 8, lines 17-20. From the attached drawing, it can be then observed that the network connection from the third information handling system to the billboard provider website can be over a cable network, and the provisional applications also disclose how the ads can be

uploaded to the billboard systems over a cable telecommunications system. As a result, Applicants respectfully assert that the provisional applications disclose that the first and second information handling systems of the first and second electronic billboard systems are coupled to the client computer (third information handling system) by a digital television broadcast network. One skilled in the art could have made and used the invention as claimed in view of the disclosures in the provisional applications.

Furthermore, in the Section 102 rejection of claims 14 and 19 in Paper No. 17, the Examiner has asserted that *Carney* discloses such a coupling of these information handling systems over a digital television network by its teaching of the use of a cable network in column 3, line 6 for each of the Internet "clouds" 22 shown in Figure 3. Therefore, by the Examiner's own admission, the limitation "digital television broadcast network" reads on a cable network, and thus this claim limitation is supported within the provisional patent applications.

The Examiner has asserted that a television network can be either digital or analog and that analog cable only serves customers a limited number of channels where digital cable provides hundreds of channels comparable to satellite, music channels, as well as more advanced pay-per-view features. The Examiner then asserts that disclosing a cable medium for transmission and access to the Internet does not disclose a digital television broadcast network. Applicants respectfully disagree. Cable mediums have been carrying digital television broadcasts for quite a few years now, and also have been carrying the Internet. Whether a broadcaster wants to place only the traditional analog channels or add the digital channels does not change the actual cable medium. When a customer contracts with the cable company to upgrade to a digital package, the cable medium stays the same.

Furthermore, one skilled in the art at the time of the filings of the provisional patent applications would have appreciated that digital television broadcasts could be

carried over cable mediums. As a result, Applicants respectfully assert that the claims are adequately supported within the provisional applications.

2. Claims 5-6, 14 and 19 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Carney* in view of *Rhoads*.

The present Application claims benefit to the Parent Application, which claims benefit to Provisional Application Serial No. 60/130,602, filed on April 22, 1999, and also claims benefit to Provisional Application Serial No. 60/147,673 filed on August 6, 1999. The *Carney* Patent was filed on November 10, 1999. Thus, the present Application has a priority based on the provisional applications from which it depends previous to the filing date of the *Carney* Patent. Applicants do recognize that the *Carney* Patent claims benefit to Provisional Application Serial No. 60/107,735, which was filed on November 10, 1998 (hereinafter "the *Carney* Provisional Application"). However, it is clear that the rejected claims are not anticipated by the disclosure in the *Carney* Provisional Application. The *Carney* Provisional Application is merely a filing of an Executive Summary, the kind of which are provided to potential investors. The *Carney* Provisional Application is not the same as the disclosure in the *Carney* Patent, nor is the disclosure in the *Carney* Provisional Application anywhere near in detail to the disclosure in the *Carney* Patent.

Clams 14 and 19

Claims 14 and 19 more specifically, with respect to claims 14 and 19, there is no disclosure in the *Carney* Provisional Application of selecting, via the third information handling system, which of the first and second electronic billboards will display the information. Nor is there a disclosure in the *Carney* Provisional Application of uploading information from the third information handling system over the Internet to the information handling system controlling the selected electronic billboard.

The Examiner's rejection requires a combination of *Carney* with *Rhoads*. The Examiner has admitted that *Carney* fails to disclose a digital television broadcast network. The Examiner goes on to assert that *Rhoads* discloses such a digital television broadcast network for transmitting video to a billboard, and cites to column 12, lines 44-56 and column 19, lines 26-30. Applicants respectfully traverse these assertions by the Examiner. An applicant may specifically challenge an obviousness rejection by showing that the Examiner reached an incorrect conclusion of obviousness or that the Examiner based the obviousness determination on incorrect factual predicates. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). The Examiner has misinterpreted the teachings of *Rhoads*. *Rhoads* is merely concerned with ways to encode and decode information, actions and links into video objects in a video sequence. Column 3, lines 49-51. Column 12, lines 41-56 cited by the Examiner merely refers to the system 800 in *Rhoads* receiving a video stream through some type of video transmission systems for then encoding a watermark into the video stream. There is no discussion of a digital television broadcast network for transmitting video to a billboard within this portion of *Rhoads*. The Examiner then also cites column 19, lines 26-30 in *Rhoads*. It is apparent that the Examiner has merely cited to this language because of the use of the term "billboards" within this cited language. This language merely describes how virtual billboards for displaying advertising can be watermarked. Since such virtual billboards are not further described within *Rhoads*, it is supposed that such virtual billboards are of the type where advertisements are displayed electronically on a background in a broadcast image, such as where advertisements are displayed on the wall behind the catcher in a baseball game. Again, this does not in any way describe or suggest a digital television broadcast network for transmitting video to a billboard. In fact, since it refers to virtual billboards, it actually implies that it does not teach or suggest such transmission of video to billboards, since with such virtual billboards, there are no physical billboards to transmit to.

As a result, the Examiner is relying upon incorrect factual predicates in interpreting the teachings of *Rhoads*. Further, one skilled in the art at the time the invention was made would not have combined *Rhoads* with *Carney* to arrive at the claimed invention. Since *Rhoads* is primarily concerned with watermarking within video streams, one skilled in the art at the time the invention was made would have had no reason to combine these two references. The Examiner has in fact stated that it would have been obvious to combine the teachings of *Carney* with the teaching in *Rhoads* of using the digital television broadcast network for transmitting video to billboards. However, as Applicants have shown above, this is not what is taught in *Rhoads*.

Clams 19 and 20.

With respect to claims 19-20, Applicants respectfully assert that the Examiner must examine these claims under *In re Donaldson* as set forth in MPEP § 2181. Applicants respectfully assert that clearly the *Carney* Patent and the *Carney* Provisional Application do not teach or suggest claims 19-20 as interpreted in view of the Specification of the present Application.

Claim 5.

With respect to claim 5, the Examiner has asserted that *Rhoads* teaches a television transmitter for transmitting the billboard information to the billboard in a wireless manner, citing column 12, line 47. This is an erroneous interpretation by the Examiner. Again, the Examiner is relying upon incorrect factual predicates for support of his obviousness rejection. Nowhere within *Rhoads* is there a teaching or suggestion of transmitting information to a billboard. Merely what is disclosed in column 12, line 47 is that a video stream may be received over a satellite broadcast, wherein this video stream is then watermarked.

Claim 6.

With respect to claim 6, the Examiner has taken Official Notice that a multiplexer is well known in a satellite television distribution system. Applicants

respectfully traverse such an assertion by the Examiner requiring the Examiner to support such an assertion with objective evidence. The present invention pertains to information to be displayed on an electronic billboard, wherein this information is carried within a signal that is then multiplexed with a digital television signal. Since Applicants assert that such a system is new and unique, it is inappropriate for the Examiner to assert that such a multiplexer is well known. Such a multiplexer is not well known, and the Examiner must provide objective evidence in support of such an assertion.

3. Claims 15-18 and 20 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Carney* in view of *Rhoads* and *Hunter* (U.S. Patent No. 6,430,605).

Applicants again assert that the *Carney* Patent is not sufficient for purposes of combining with *Hunter*, since the *Carney* Patent is not prior art to the present application by itself and the *Carney* Provisional Application disclosure is not in any way as detailed, nor is it enabling, in order to suffice for the Examiner's purposes. In fact, all of the Examiner's § 103 arguments are insufficient to prove a *prima facie* case of obviousness, since the Examiner is relying upon language cited within the *Carney* Patent. Since this language cited in the *Carney* Patent does not exist within the *Carney* Provisional Application, such Examiner arguments do not provide a *prima facie* case of obviousness.

Applicants incorporate their assertions above with respect to *Rhoads*. The Examiner has incorrectly interpreted the teachings of *Rhoads* to combine *Rhoads* with *Carney* and *Hunter*.

The Examiner has admitted that *Carney* and *Rhoads* fail to teach a time period for displaying information on the billboard and displaying the information for the specified time period. The Examiner has asserted that *Hunter* teaches such limitations. Applicants respectfully traverse, because *Hunter* is not proper prior art to the present invention. As noted above, the present invention claims priority to

Provisional Patent Application Serial No. 60/130,602. Within this provisional application, it is disclosed to view a list of open times available for ad space for a selected billboard, permitting the client to select such an available time slot, and then having the client upload the created ad to the system for download to the selected billboard for display at the selected time period. This provisional patent application was filed on April 22, 1999, which predates the earliest of *Hunter's* family of applications of April 28, 1999. As a result, the Examiner's § 103 rejections of claims 15-18 and 20 cannot stand.

Respectfully submitted,
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